

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/08 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-16, 18, 19 and 21-30 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbin et al. (US 2005/0197892) in view of Fredman (6,526,393) and Tilles et al. (5,518,122).

4. With respect to Claims 14, 15 and 42: Bilbin discloses the use of a method for franking and processing parcels comprising the steps of:

- a. receiving a parcel franking request from a customer relating to an anticipated delivery, the request comprising delivery data including the address of the recipient (See Claim 1);

- b. generating a franking number for the delivery (See Tracking number, Figure 58);
 - c. storing the franking number and delivery data in a database (Paragraph 0419 and 420, System database 22);
 - d. transferring the franking number from the dispatch service to the customer for application by the customer in human readable form and where the delivery includes the franking number and the recipient data (See Figure 58 with corresponding detailed description, the label is generated then sent to the customer, for application onto a package, as well as Paragraphs 0375, 0395 and 0401); and
 - e. using the franking number during processing of the delivery to access the delivery data in the database (Paragraphs 0435 and 0448).
2. Bilbin however fails to disclose assigning a validity time period to the franking number. Fredman discloses a pre-paid shipping label with a tracking number and an expiration date (the shipping label has an expiration date, therefore the examiner considers the corresponding tracking number to have an expiration date). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Bilbin, to include the expiration date, as disclosed by Fredman, in order to encourage users to take action (i.e. ship package) in a timely manner (see Fredman, abstract).
3. Bilbin and Fredman disclose the use of franking numbers with corresponding recipient address, and Bilbin discloses if the information is correct mailing the item (Paragraph 0048), however fail to disclose reading a recipient address and the franking number on the delivery, accessing the delivery data in the database and determining whether the read address corresponds to the delivery data associated with the franking number. Tilles discloses a mail system which

reads the address label and checks the address which that in an address database, to ensure that the correct address and barcode is printed on the mail or mailing label (See Column 9, lines 18-40). All of the method steps are known in Bilbin, Fredman and Tilles. The only difference is the combination of the "old methods" into a single method of processing a delivery. Therefore, it would have been obvious to use the checksum method of Tilles, with the assigning a franking number of Bilbin, since they would produce the predictable result of making a delivery more efficient and for verifying information on a delivery. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

4. With respect to Claim 16: Bilbin discloses the use of receiving payment means (Paragraph 0367).
5. With respect to Claim 18: Bilbin discloses the franking number is alphanumeric (See Paragraphs 416-417).
6. With respect to Claim 21: See Bilbin, Figure 0058.
7. With respect to Claim 25: Bilbin discloses the address is printed out, which is in OCR format, as long as it is an alphanumeric character, it is in OCR format, See Figure 58.
8. With respect to Claim 26: See Bilbin Paragraph 0367.
9. With respect to Claims 27 and 28: Bilbin discloses the use of a carrier system, which assigns carrier tracking numbers and uses the tracking numbers for tracking the parcel through the delivery process (Paragraphs 0449-0451).
10. With respect to Claim 29: Bilbin discloses determining the charge for shipping and charging the sender (See Bilbin, Paragraph 0367).

11. With respect to Claim 30: Bilbin discloses that the cost is based on a weight, size and delivery service used (Paragraphs 0192 and 0205).

12. With respect to Claim 19: Bilbin discloses the use of a tracking/franking number, however fails to disclose the initial franking number is a symbol. However, the way the tracking number is arranged, whether they be alpha numeric characters, or symbols is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The tracking steps would be performed the same regardless of what type of character comes first in the franking number. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

13. With respect to Claims 22-24: Bilbin also fails to disclose the limitations of validating the delivery address, checking to see if the address is in a forward address database, updating the address and informing the sending of the forwarded address. Official notice is taken that it is old and well known with the mailing/shipping art, that when anything goes through the mail system the address is checked with a forwarding address database, and the address is forwarded (when you get mail that has been forwarded to you, there is a yellow address label placed on the envelope that states the letter has been forwarded), and on the envelope there is a statement of "address correction requested" which means the sending is notified of the forwarded address. Therefore, one of ordinary skill in the art would have been motivated to check the address for a

forwarding address, to ensure the letter/mailling/parcel, gets to the correct person at the correct address.

Response to Arguments

14. Applicant's arguments with respect to claims 14-16, 18, 19, 21-30 and 42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Connell (5,229,932) discloses the use of certifying mail batches.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629